IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Phyllis A. Ellendman

Confirmation No: 8593

Application No: 09/916,971

Examiner: Michael Roswell

Filing Date: July 26, 2001

Group Art Unit: 2173

SUBJECT: E-MAIL DISTRIBUTION WITH VERSATILE ADDRESS REMOVAL

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPEAL BRIEF

Appellant herein sets forth his reasons and arguments for appealing the Examiner's final rejection of claims in the above-identified case.

REAL PARTY IN INTEREST

This Patent Application has been assigned to Hewlett-Packard Development Company, L.P., a Texas Limited Partnership having it principal place of business in Houston, Texas.

RELATED APPEALS AND INTERFERENCES

Appellant is aware of no related appeals or interferences.

STATUS OF CLAIMS

Claims 1 through 14 are pending in the case.

Claims 1 through 14 are rejected.

The appealed claims are claims 1 through 14.

STATUS OF AMENDMENTS

After the final rejection, Appellant filed a Response dated July 9, 2005.
The Response did not include any amendments to the case.

SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1:

Claim 1 sets out a method for sending an electronic message. In
preparation for sending an e-mail message (11,20), any addresses within a
field (26) of the e-mail message used to specify addresses to be removed from
the "To" field (21) are removed from any addresses specified in a "To" field (21)
of the e-mail message. The e-mail message (11,20) is then sent. An example
of a "To" field (21) and a "Remove" field (26) is shown in Figure 2. See, for
example, the Specification at page 3, line 19 through page 5, line 10.

Claim 8:

Claim 8 sets out a method for sending an electronic message. In
preparation for sending an e-mail message (11,20,60), any addresses within a

field (24,64) of the e-mail message used to specify addresses to be removed from all address fields are removed from any addresses specified in a "To" field (21,61), a "Cc" field (22,62) and a "Bcc" field (23,63) of the e-mail message (11,20,60). The e-mail message (11,20,60) is then sent.

An example of a "To" field (21), a "Cc" field (22), a "Bcc" field (23) and a "Remove" field (26) is shown in Figure 2. See, for example, the Specification at page 3, lines 14 through 18 and at page 6, line 22 through page 7, line 5.

Another example of a "To" field (61), a "Cc" field (62), a "Bcc" field (63) and a "Remove" field (64) is shown in Figure 6. See, for example, the Specification at page 1, lines 1 through 6.

Claim 9:

Claim 9 sets out an electronic mail system for generating a message (11,20,60) for being sent electronically. The message comprises a "To" field (21,61) for listing primary addresses to receive the message, and a field (26,64) used to specify addresses to be removed from the "To" field (21,61) in preparation for sending the message.

An example of a "To" field (21) and a "Remove" field (26) is shown in Figure 2. See, for example, the Specification at page 3, line 19 through page 5, line 10.

Another example of a "To" field (61), and a "Remove" field (64) is shown in Figure 6. See, for example, the Specification at page 1, lines 1 through 6.

Claim 14:

Claim 14 sets out an electronic mail system for generating a message (11,20,60) for being sent electronically, the message comprises a plurality of address fields. The address fields include a "To" field (21,61) for listing primary addresses to receive the message; a "Cc" field (22,62) for listing addresses to receive a copy of the message; a "Bcc" field (23,63) for listing addresses to receive a blind copy of the message; and, a field (24,64) used to specify addresses to be removed from the address fields in preparation for sending the message.

An example of a "To" field (21), a "Cc" field (22), a "Bcc" field (23) and a "Remove" field (26) is shown in Figure 2. See, for example, the Specification at page 3, lines 14 through 18 and at page 6, line 22 through page 7, line 5.

Another example of a "To" field (61), a "Cc" field (62), a "Bcc" field (63) and a "Remove" field (64) is shown in Figure 6. See, for example, the Specification at page 1, lines 1 through 6.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

(1) Claims 1 to 22 stand rejected under 35 U.S.C. § 102 (b) as anticipated the software program: Microsoft Corp. "Microsoft Outlook 2000". 1999 (*Outlook*). The Examiner has generated Figures 1 through 3 using *Outlook*. The Examiner

regards the generated Figures 1 through 3 as part of subject matter disclosed by *Outlook*.

ARGUMENT

A. Overview of Errors in the Rejection of the Claims under 35 U.S.C. 102.

The criteria for a rejection under 35 U.S.C. § 102(b) has been defined by the courts and confirmed by the U.S. Patent and Trademark Office. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Examiner has failed to show that each and every element set forth in the claims is found either expressly or inherently by the cited art. Rather, the Examiner, using the program *Outlook*, has created figures that the Examiner avers discloses the subject matter of the invention. The two figures (Figures 2 and 3) relied upon by the Examiner in the rejection were not published by Microsoft, but were created by the Examiner after the filing date of the present case. Furthermore, it is clear that the Examiner relied upon the teaching within the claims and Specification of the present case in order to create the figures.

B. Discussion of claims 1 through 7

Independent claim 1 sets out a method for sending an electronic message. In preparation for sending an e-mail message, any addresses within a field of the e-mail message used to specify addresses to be removed from the "To" field are removed from any addresses specified in a "To" field of the e-mail message. The e-mail message is then sent.

Subject Matter within Independent Claim 1 not Disclosed by *Outlook*

Outlook does not disclose or suggest that in preparation for sending an e-mail message, any addresses within a field of the e-mail message used to specify addresses to be removed from the "To" field are removed from any addresses specified in a "To" field of the e-mail message.

What *Outlook* Discloses

Outlook discloses a standard e-mail program, such as that discussed by Appellant in the Specification and labeled as prior art in Figure 1 of Appellant's Application. Specifically, *Outlook* discloses e-mail messages that can include a "To" field, a "CC" field and a "BCC" field. *Outlook* does not does not disclose or suggest that in preparation for sending an e-mail message, any addresses within a field of the e-mail message used to specify addresses to be removed from the "To" field are removed from any addresses specified in a "To" field of the e-mail message, as set out in Claim 1 of the present case.

Errors the Examiner Made in Rejection

The three figures:

The Examiner has utilized three figures to illustrate what the Examiner asserts is functionality available within *Outlook*. The copies of the three figures sent to Appellant are of poor quality, with much of the dark sections being completely blacked out. However, enough of the three figures is decipherable to make clear that these three figures do not qualify as prior art under 35 U.S.C. § 102 (b).

According to the Examiner, Figure 1 includes copyright and publication dates for *Outlook*. Appellant is relying on the Examiner's description of this figure as the print on Figure 1 is unreadable in the copy received by Appellant.

From the readable parts of Figure 2, it looks like the Examiner has printed a screen shot of an untitled e-mail message that the Examiner has prepared. It looks like the e-mail message is variously addressed to Roswell, Michael; 2173 Examiners; Detwiler, Brian; 2174 Examiners; Bonshock, Dennis; 2179 Examiners and Cabeca, John. In the part of the e-mail message where the message text normally is placed, Examiner has apparently typed the phrase: "Do not send to: Michael Roswell; 2174 Examiners; John Cabeca; Brian Detwiler".

From the readable parts of Figure 3, it looks like the Examiner has printed a screen shot of the same untitled e-mail message shown in Figure 2, with some minor modifications. Specifically, it looks like the Examiner has

removed some of addresses from the untitled e-mail message shown in Figure 2. Specifically, the Examiner has removed the names: Michael Roswell; 2174 Examiners; John Cabeca; Brian Detwiler.

In order for Figures 2 and 3 created by the Examiner to qualify as prior art under 35 U.S.C. § 102 (b), it would be necessary for the Examiner to show that Figures 2 and 3 were in a printed publication in this or a foreign country more than one year prior to the date of the application for patent in the United States. However, it is clear that Figures 2 and 3 are very recent creations by the Examiner and were not published before July 26, 2000 (one year prior to the filing date of the present application). Therefore, Figures 2 and 3 are not available as prior art for purposes of evaluating the claims of the present case under 35 U.S.C. § 102(b).

Appellant notes that it should be possible in light of the teaching in Appellant's Specification, to modify *Outlook* in a way to fall within the subject matter set out in the claims of the present case. However, such a modification or use of *Outlook* to, in hindsight from Appellant's Specification, recreate the subject matter set out in the claims of the present case only serves to show that Appellant has satisfied the requirement of first paragraph of 35 U.S.C. § 112 that the specification shall contain a written description of the invention and of the manner and process of making and using it, in such full clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.

The Examiner's ability to modify or use *Outlook*, in hindsight from

Appellant's teaching, to reproduce the subject of the claims of the present case does not demonstrate that the subject matter of the claims is anticipated. For anticipation under 35 U.S.C. § 102 (b), the Examiner must show that such a modification or use occurred before July 26, 2000 (one year prior to the filing date of the present Application).

Response to the Examiner's argument that any demonstrated usage of *Outlook* may rely upon the given publishing date:

The Examiner has argued as follows:

> In response to applicant's argument that the Outlook reference fails to qualify as prior art under 35 U.S.C. § 102(b) the Examiner respectfully disagrees. The publishing date of MICROSOFT OUTLOOK 2000, as demonstrated by the newly cited copyright registration record, is 10 June 1999. Therefore, any demonstrated usage of Outlook may rely upon the given publishing date. Thus, the Examiner contends that the cited Outlook reference is valid prior art under 35 U.S.C. § 102(b).

See the Office Action dated June 1, 2005, on page 3, lines 15 through 20.

Appellant recognizes that a publishing date of June 10, 1999 is more than one year prior to the filing date (July 26, 2001) of the present application. Therefore, any material that is included within such a publication qualifies as prior art under 35 U.S.C. § 102 (b).

However, Appellant notes that the three Figures created by the Examiner were not included within the copyrighted material published on June 10, 1999.

Specifically, Figure 2 and Figure 3 of what the Examiner has called "Outlook" are apparently screen shots the Examiner has created with the use of *Outlook*. Appellant does not believe that Figure 2 and Figure 3 created by the

Examiner using *Outlook* actually appeared in any publication that was available to the public prior to July 26, 2000 (one year prior to the filing date of the present application).

The Examiner has failed to recognize that there is a difference between a computer program, and works created with the aid of a computer program. Specifically, the Examiner has asserted the following: "... any demonstrated usage of *Outlook* may rely upon the given publishing date." This is clearly a wrong standard for evaluating claims in a patent application.

For example, an examiner examining a patent application should be able, after reading a claim in a patent application, to use the drawing feature within Microsoft Office (provided the examiner is proficient with this program) to create a drawing that corresponds to the subject matter set out in the claim.

The examiner, however, cannot assert that the figures that the examiner himself created is prior art, and that the figures created by the Examiner be accorded a publication date based on the publication of the computer program (e.g., Microsoft Office) used to create the drawing.

If this were the criteria by which claims were evaluated, it is difficult to see how any claim could survive scrutiny. It is always possible to use a computer program to generate information that discloses the claimed subject matter of an invention. The vast majority of patent applications are written using computer programs. Thus, an examiner should always be able to reproduce the subject matter set out in any claim using a computer program. However, such a reproduction by the examiner should not be regarded as

having the same publication date as the publication date of the computer

program the examiner uses to create the reproduction.

In effect, this is what the Examiner has done in this case. The Examiner

has used the program MICROSOFT OUTLOOK 2000, available from Microsoft

Corporation to produce Figures 2 and 3. The Examiner has argued that Figures 2

and 3, which the Examiner has himself created, should be regarded as having the

same publication date as the computer program MICROSOFT OUTLOOK 2000,

available from Microsoft Corporation. This is an incorrect standard for a

rejection under 35 U.S.C. § 102.

<u>The standard utilized by the Examiner, if adopted generally for examination of
patent applications, would disqualify most, if not all, patent applications from
allowance:</u>

The Examiner's has used Appellant's specification to reproduce the subject

matter set out in the claims. The Examiner has argued that such a reconstruction

from hindsight of the subject matter of the claims is grounds for rejection of the

claims under 35 U.S.C. § 102(b).

Appellant grants that claims vary in complexity and the subject matter of

some claims are easier to reconstruct than others; however, the Appellant is of

the belief that with varying amounts of effort, the subject matter of most claims

could be reconstructed by a skilled examiner from hindsight of information

disclosed by the claims and/or the related specification. In the few cases where

this was not possible, an examiner might have an argument that the

requirements of the first paragraph of 35 U.S.C. § 112 are not met. That is, the

specification does not contain a written description of the invention and of the

manner and process of making and using it, in such full clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.

The Appellant believes that if the USPTO were to adopt the methodology used by the Examiner in this case to find claims anticipated by 35 U.S.C. § 102, this along with a judicious use of rejections under the first paragraph of 35 U.S.C. § 112 should disqualify most, if not all, patent applications from allowance. This would place in serious jeopardy the patent system currently in place in the U.S. At the very least, it would severely discourage inventors from seeking protection from the U.S. patent system.

C. Discussion of claim 8

Independent claim 8 sets out a method for sending an electronic message. In preparation for sending an e-mail message, any addresses within a field of the e-mail message used to specify addresses to be removed from the "To" field are removed from any addresses specified in a "To" field of the e-mail message. The e-mail message is then sent.

Subject Matter within Independent Claim 1 not Disclosed by *Outlook*

Outlook does not disclose or suggest that in preparation for sending an e-mail message, any addresses within a field of the e-mail message used to specify addresses to be removed from the "To" field are removed from any addresses specified in a "To" field of the e-mail message.

What *Outlook* Discloses

Outlook discloses a standard e-mail program, such as that discussed by Appellant in the Specification and labeled as prior art in Figure 1 of Appellant's Application. Specifically, *Outlook* discloses e-mail messages that can include a "To" field, a "CC" field and a "BCC" field. *Outlook* does not does not disclose or suggest that preparation for sending an e-mail message, any addresses within a field of the e-mail message used to specify addresses to be removed from the "To" field are removed from any addresses specified in a "To" field of the e-mail message, as set out in Claim 8 of the present case.

Errors the Examiner Made in Rejection

The three figures:

The Examiner has sent three figures to illustrate functionality available within *Outlook*. From the readable parts of Figure 2, it looks like the Examiner has printed a screen shot of an untitled e-mail message that the Examiner has prepared. It looks like the e-mail message is variously addressed to Roswell, Michael; 2173 Examiners; Detwiler, Brian; 2174 Examiners; Bonshock, Dennis; 2179 Examiners and Cabeca, John. In the part of the e-mail message where the message text normally is placed, Examiner has apparently typed the phrase: "Do not send to: Michael Roswell; 2174 Examiners; John Cabeca; Brian Detwiler".

From the readable parts of Figure 3, it looks like the Examiner has printed a screen shot of the same untitled e-mail message shown in Figure 2, with some minor modifications. Specifically, it looks like the Examiner has removed some of addresses from the untitled e-mail message shown in Figure 2. Specifically, the Examiner has removed the names: Michael Roswell; 2174 Examiners; John Cabeca; Brian Detwiler.

In order for Figures 2 and 3 created by the Examiner to qualify as prior art under 35 U.S.C. § 102 (b), it would be necessary for the Examiner to show that Figures 2 and 3 were in a printed publication in this or a foreign country more than one year prior to the date of the application for patent in the United States. However, it is clear that Figures 2 and 3 are very recent creations by the Examiner and were not published before July 26, 2000 (one year prior to the filing date of the present application). Therefore, Figures 2 and 3 are not available as prior art for purposes of evaluating the claims of the present case under 35 U.S.C. § 102(b).

Appellant notes that it should be possible in light of the teaching in Appellant's Specification, to modify *Outlook* in a way to fall within the subject matter set out in the claims of the present case. However, such a modification or use of *Outlook* to, in hindsight from Appellant's Specification, recreate the subject matter set out in the claims of the present case only serves to show that Appellant has satisfied the requirement of first paragraph of 35 U.S.C. § 112 that the specification shall contain a written description of the invention and of the manner and process of making and using it, in such full clear, concise, and exact

terms as to enable any person skilled in the art to which it pertains, or with

which it is most nearly connected, to make and use the same.

The Examiner's ability to modify or use *Outlook*, in hindsight from

Appellant's teaching, to reproduce the subject of the claims of the present case

does not demonstrate that the subject matter of the claims is anticipated. For

anticipation under 35 U.S.C. § 102 (b), the Examiner must show that such a

modification or use occurred before July 26, 2000 (one year prior to the filing

date of the present Application).

Response to the Examiner's argument that any demonstrated usage of *Outlook*
may rely upon the given publishing date:

The Examiner has argued as follows:

> In response to applicant's argument that the Outlook reference
> fails to qualify as prior art under 35 U.S.C. § 102(b) the Examiner
> respectfully disagrees. The publishing date of MICROSOFT
> OUTLOOK 2000, as demonstrated by the newly cited copyright
> registration record, is 10 June 1999. Therefore, any demonstrated
> usage of Outlook may rely upon the given publishing date. Thus,
> the Examiner contends that the cited Outlook reference is valid
> prior art under 35 U.S.C. § 102(b).

See the Office Action dated June 1, 2005, on page 3, lines 15 through 20.

Appellant recognizes that a publishing date of June 10, 1999 is more than

one year prior to the filing date (July 26, 2001) of the present application.

Therefore, any material that is included within such a publication qualifies as

prior art under 35 U.S.C. § 102 (b).

However, Appellant notes that the three Figures created by the Examiner

were not included within the copyrighted material published on June 10, 1999.

Specifically, Figure 2 and Figure 3 of what the Examiner has called "Outlook" are apparently screen shots the Examiner has created with the use of *Outlook*. Appellant does not believe that Figure 2 and Figure 3 created by the Examiner using *Outlook* actually appeared in any publication that was available to the public prior to July 26, 2000 (one year prior to the filing date of the present application).

The Examiner has failed to recognize that there is a difference between a computer program, and works created with the aid of a computer program. Specifically, the Examiner has asserted the following: "... any demonstrated usage of *Outlook* may rely upon the given publishing date." This is clearly a wrong standard for evaluating claims in a patent application.

For example, an examiner examining a patent application should be able, after reading a claim in a patent application, to use the drawing feature within Microsoft Office (provided the examiner is proficient with this program) to create a drawing that corresponds to the subject matter set out in the claim.

The examiner, however, cannot assert that the figures that the examiner himself created is prior art, and that the figures created by the Examiner be accorded a publication date based on the publication of the computer program (e.g., Microsoft Office) used to create the drawing.

If this were the criteria by which claims were evaluated, it is difficult to see how any claim could survive scrutiny. It is always possible to use a computer program to generate information that discloses the claimed subject matter of an invention. The vast majority of patent applications are written

using computer programs. Thus, an examiner should always be able to reproduce the subject matter set out in any claim using a computer program. However, such a reproduction by the examiner should not be regarded as having the same publication date as the publication date of the computer program the examiner uses to create the reproduction.

In effect, this is what the Examiner has done in this case. The Examiner has used the program MICROSOFT OUTLOOK 2000, available from Microsoft Corporation to produce Figures 2 and 3. The Examiner has argued that Figures 2 and 3, which the Examiner has himself created, should be regarded as having the same publication date as the computer program MICROSOFT OUTLOOK 2000, available from Microsoft Corporation. This is an incorrect standard for a rejection under 35 U.S.C. § 102.

D. Discussion of claims 9 through 13

Independent claim 9 sets out an electronic mail system for generating a message (11,20,60) for being sent electronically. The message comprises a "To" field (21,61) for listing primary addresses to receive the message, and a field (26,64) used to specify addresses to be removed from the "To" field (21,61) in preparation for sending the message.

Subject Matter within Independent Claim 1 not Disclosed by *Outlook*

Outlook does not disclose or suggest a message comprises a "To" field (21,61) for listing primary addresses to receive the message, and a field (26,64)

used to specify addresses to be removed from the "To" field (21,61) in preparation for sending the message.

What *Outlook* Discloses

Outlook discloses a standard e-mail program, such as that discussed by Appellant in the Specification and labeled as prior art in Figure 1 of Appellant's Application. Specifically, *Outlook* discloses e-mail messages that can include a "To" field, a "CC" field and a "BCC" field. *Outlook* does not does not disclose or suggest a message comprises a "To" field (21,61) for listing primary addresses to receive the message, and a field (26,64) used to specify addresses to be removed from the "To" field (21,61) in preparation for sending the message, as set out in Claim 9 of the present case.

Errors the Examiner Made in Rejection

The three figures:

The Examiner has sent three figures to illustrate functionality available within *Outlook*. From the readable parts of Figure 2, it looks like the Examiner has printed a screen shot of an untitled e-mail message that the Examiner has prepared. It looks like the e-mail message is variously addressed to Roswell, Michael; 2173 Examiners; Detwiler, Brian; 2174 Examiners; Bonshock, Dennis; 2179 Examiners and Cabeca, John. In the part of the e-mail message where the message text normally is placed, Examiner has apparently typed the phrase:

"Do not send to: Michael Roswell; 2174 Examiners; John Cabeca; Brian Detwiler".

From the readable parts of Figure 3, it looks like the Examiner has printed a screen shot of the same untitled e-mail message shown in Figure 2, with some minor modifications. Specifically, it looks like the Examiner has removed some of addresses from the untitled e-mail message shown in Figure 2. Specifically, the Examiner has removed the names: Michael Roswell; 2174 Examiners; John Cabeca; Brian Detwiler.

In order for Figures 2 and 3 created by the Examiner to qualify as prior art under 35 U.S.C. § 102 (b), it would be necessary for the Examiner to show that Figures 2 and 3 were in a printed publication in this or a foreign country more than one year prior to the date of the application for patent in the United States. However, it is clear that Figures 2 and 3 are very recent creations by the Examiner and were not published before July 26, 2000 (one year prior to the filing date of the present application). Therefore, Figures 2 and 3 are not available as prior art for purposes of evaluating the claims of the present case under 35 U.S.C. § 102(b).

Appellant notes that it should be possible in light of the teaching in Appellant's Specification, to modify *Outlook* in a way to fall within the subject matter set out in the claims of the present case. However, such a modification or use of *Outlook* to, in hindsight from Appellant's Specification, recreate the subject matter set out in the claims of the present case only serves to show that Appellant has satisfied the requirement of first paragraph of 35 U.S.C. § 112 that

the specification shall contain a written description of the invention and of the manner and process of making and using it, in such full clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.

The Examiner's ability to modify or use *Outlook*, in hindsight from Appellant's teaching, to reproduce the subject of the claims of the present case does not demonstrate that the subject matter of the claims is anticipated. For anticipation under 35 U.S.C. § 102 (b), the Examiner must show that such a modification or use occurred before July 26, 2000 (one year prior to the filing date of the present Application).

Response to the Examiner's argument that any demonstrated usage of *Outlook* may rely upon the given publishing date:

The Examiner has argued as follows:

> In response to applicant's argument that the Outlook reference fails to qualify as prior art under 35 U.S.C. § 102(b) the Examiner respectfully disagrees. The publishing date of MICROSOFT OUTLOOK 2000, as demonstrated by the newly cited copyright registration record, is 10 June 1999. Therefore, any demonstrated usage of Outlook may rely upon the given publishing date. Thus, the Examiner contends that the cited Outlook reference is valid prior art under 35 U.S.C. § 102(b).

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Appellant recognizes that a publishing date of June 10, 1999 is more than one year prior to the filing date (July 26, 2001) of the present application. Therefore, any material that is included within such a publication qualifies as prior art under 35 U.S.C. § 102 (b).

However, Appellant notes that the three Figures created by the Examiner were not included within the copyrighted material published on June 10, 1999.

Specifically, Figure 2 and Figure 3 of what the Examiner has called "Outlook" are apparently screen shots the Examiner has created with the use of *Outlook*. Appellant does not believe that Figure 2 and Figure 3 created by the Examiner using *Outlook* actually appeared in any publication that was available to the public prior to July 26, 2000 (one year prior to the filing date of the present application).

The Examiner has failed to recognize that there is a difference between a computer program, and works created with the aid of a computer program. Specifically, the Examiner has asserted the following: "... any demonstrated usage of *Outlook* may rely upon the given publishing date." This is clearly a wrong standard for evaluating claims in a patent application.

For example, an examiner examining a patent application should be able, after reading a claim in a patent application, to use the drawing feature within Microsoft Office (provided the examiner is proficient with this program) to create a drawing that corresponds to the subject matter set out in the claim.

The examiner, however, cannot assert that the figures that the examiner himself created is prior art, and that the figures created by the Examiner be accorded a publication date based on the publication of the computer program (e.g., Microsoft Office) used to create the drawing.

If this were the criteria by which claims were evaluated, it is difficult to see how any claim could survive scrutiny. It is always possible to use a

computer program to generate information that discloses the claimed subject matter of an invention. The vast majority of patent applications are written using computer programs. Thus, an examiner should always be able to reproduce the subject matter set out in any claim using a computer program. However, such a reproduction by the examiner should not be regarded as having the same publication date as the publication date of the computer program the examiner uses to create the reproduction.

In effect, this is what the Examiner has done in this case. The Examiner has used the program MICROSOFT OUTLOOK 2000, available from Microsoft Corporation to produce Figures 2 and 3. The Examiner has argued that Figures 2 and 3, which the Examiner has himself created, should be regarded as having the same publication date as the computer program MICROSOFT OUTLOOK 2000, available from Microsoft Corporation. This is an incorrect standard for a rejection under 35 U.S.C. § 102.

E. Discussion of claim 14

Independent claim 14 sets out an electronic mail system for generating a message for being sent electronically, the message comprises a plurality of address fields. The address fields include a "To" field for listing primary addresses to receive the message; a "Cc" field for listing addresses to receive a copy of the message; a "Bcc" field for listing addresses to receive a blind copy of the message; and, a field used to specify addresses to be removed from the address fields in preparation for sending the message.

Subject Matter within Independent Claim 1 not Disclosed by *Outlook*

Outlook does not disclose or suggest a field used to specify addresses to be removed from the address fields of a message in preparation for sending the message.

What *Outlook* Discloses

Outlook discloses a standard e-mail program, such as that discussed by Appellant in the Specification and labeled as prior art in Figure 1 of Appellant's Application. Specifically, *Outlook* discloses e-mail messages that can include a "To" field, a "CC" field and a "BCC" field. *Outlook* does not does not disclose or suggest a field used to specify addresses to be removed from the address fields of a message in preparation for sending the message, as set out in Claim 14 of the present case.

Errors the Examiner Made in Rejection

The three figures:

The Examiner has sent three figures to illustrate functionality available within *Outlook*. From the readable parts of Figure 2, it looks like the Examiner has printed a screen shot of an untitled e-mail message that the Examiner has prepared. It looks like the e-mail message is variously addressed to Roswell, Michael; 2173 Examiners; Detwiler, Brian; 2174 Examiners; Bonshock, Dennis; 2179 Examiners and Cabeca, John. In the part of the e-mail message where the

message text normally is placed, Examiner has apparently typed the phrase: "Do not send to: Michael Roswell; 2174 Examiners; John Cabeca; Brian Detwiler".

From the readable parts of Figure 3, it looks like the Examiner has printed a screen shot of the same untitled e-mail message shown in Figure 2, with some minor modifications. Specifically, it looks like the Examiner has removed some of addresses from the untitled e-mail message shown in Figure 2. Specifically, the Examiner has removed the names: Michael Roswell; 2174 Examiners; John Cabeca; Brian Detwiler.

In order for Figures 2 and 3 created by the Examiner to qualify as prior art under 35 U.S.C. § 102 (b), it would be necessary for the Examiner to show that Figures 2 and 3 were in a printed publication in this or a foreign country more than one year prior to the date of the application for patent in the United States. However, it is clear that Figures 2 and 3 are very recent creations by the Examiner and were not published before July 26, 2000 (one year prior to the filing date of the present application). Therefore, Figures 2 and 3 are not available as prior art for purposes of evaluating the claims of the present case under 35 U.S.C. § 102(b).

Appellant notes that it should be possible in light of the teaching in Appellant's Specification, to modify *Outlook* in a way to fall within the subject matter set out in the claims of the present case. However, such a modification or use of *Outlook* to, in hindsight from Appellant's Specification, recreate the subject matter set out in the claims of the present case only serves to show that

Appellant has satisfied the requirement of first paragraph of 35 U.S.C. § 112 that the specification shall contain a written description of the invention and of the manner and process of making and using it, in such full clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.

The Examiner's ability to modify or use *Outlook*, in hindsight from Appellant's teaching, to reproduce the subject of the claims of the present case does not demonstrate that the subject matter of the claims is anticipated. For anticipation under 35 U.S.C. § 102 (b), the Examiner must show that such a modification or use occurred before July 26, 2000 (one year prior to the filing date of the present Application).

Response to the Examiner's argument that any demonstrated usage of *Outlook* may rely upon the given publishing date:

The Examiner has argued as follows:

> In response to applicant's argument that the Outlook reference fails to qualify as prior art under 35 U.S.C. § 102(b) the Examiner respectfully disagrees. The publishing date of MICROSOFT OUTLOOK 2000, as demonstrated by the newly cited copyright registration record, is 10 June 1999. Therefore, any demonstrated usage of Outlook may rely upon the given publishing date. Thus, the Examiner contends that the cited Outlook reference is valid prior art under 35 U.S.C. § 102(b).

See the Office Action dated June 1, 2005, on page 3, lines 15 through 20.

Appellant recognizes that a publishing date of June 10, 1999 is more than one year prior to the filing date (July 26, 2001) of the present application.

Therefore, any material that is included within such a publication qualifies as prior art under 35 U.S.C. § 102 (b).

However, Appellant notes that the three Figures created by the Examiner were not included within the copyrighted material published on June 10, 1999.

Specifically, Figure 2 and Figure 3 of what the Examiner has called "Outlook" are apparently screen shots the Examiner has created with the use of *Outlook*. Appellant does not believe that Figure 2 and Figure 3 created by the Examiner using *Outlook* actually appeared in any publication that was available to the public prior to July 26, 2000 (one year prior to the filing date of the present application).

The Examiner has failed to recognize that there is a difference between a computer program, and works created with the aid of a computer program. Specifically, the Examiner has asserted the following: "... any demonstrated usage of *Outlook* may rely upon the given publishing date." This is clearly a wrong standard for evaluating claims in a patent application.

For example, an examiner examining a patent application should be able, after reading a claim in a patent application, to use the drawing feature within Microsoft Office (provided the examiner is proficient with this program) to create a drawing that corresponds to the subject matter set out in the claim.

The examiner, however, cannot assert that the figures that the examiner himself created is prior art, and that the figures created by the Examiner be accorded a publication date based on the publication of the computer program (e.g., Microsoft Office) used to create the drawing.
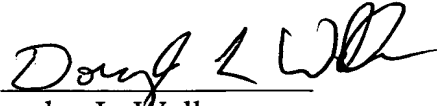
If this were the criteria by which claims were evaluated, it is difficult to see how any claim could survive scrutiny. It is always possible to use a computer program to generate information that discloses the claimed subject matter of an invention. The vast majority of patent applications are written using computer programs. Thus, an examiner should always be able to reproduce the subject matter set out in any claim using a computer program. However, such a reproduction by the examiner should not be regarded as having the same publication date as the publication date of the computer program the examiner uses to create the reproduction.

In effect, this is what the Examiner has done in this case. The Examiner has used the program MICROSOFT OUTLOOK 2000, available from Microsoft Corporation to produce Figures 2 and 3. The Examiner has argued that Figures 2 and 3, which the Examiner has himself created, should be regarded as having the same publication date as the computer program MICROSOFT OUTLOOK 2000, available from Microsoft Corporation. This is an incorrect standard for a rejection under 35 U.S.C. § 102.

CONCLUSION

For all the reasons discussed above, Appellant believes the rejection of

the claims was in error and respectfully requests that the rejection be reversed.

Respectfully submitted,
PHYLLIS A. ELLENDMAN

By _Doug L Wll_
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August 31, 2005
Santa Clara, California
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CLAIMS APPENDIX

1. (Previously Presented) A method for sending an electronic message comprising the following steps:

(a) in preparation for sending an e-mail message, performing the following substep:

(a.1) removing from any addresses specified in a "To" field of the e-mail message, any addresses within a field of the e-mail message used to specify addresses to be removed from the "To" field; and,

(b) sending the e-mail message.

2. (Original) A method as in claim 1 wherein step (a) additionally comprises the following substep:

(a.2) removing from any addresses specified in a "Cc" field, any addresses within a field used to specify addresses to be removed from the "Cc" field.

3. (Original) A method as in claim 1 wherein step (a) additionally comprises the following substep:

(a.2) removing from any addresses specified in a "Bcc" field, any addresses within a field used to specify addresses to be removed from the "Bcc" field.

4. (Original) A method as in claim 1 wherein in substep (a.1) at least a subset of addresses to be removed from the "To" field are specified using a group list.

5. (Original) A method as in claim 1 wherein in substep (a.1) at least a subset of addresses to be removed from the "To" field are specified using at least one group list and at least one individually listed address.

6. (Original) A method as in claim 1 wherein step (a) additionally comprises the following substep:

(a.2) removing from any addresses specified in the "To" field, any addresses within a field used to specify addresses to be removed from all address fields.

7. (Original) A method as in claim 1 wherein step (a) additionally comprises the following substeps:

(a.2) removing from any addresses specified in a "Cc" field, any addresses within a field used to specify addresses to be removed from the "Cc" field;

(a.3) removing from any addresses specified in a "Bcc" field, any addresses within a field used to specify addresses to be removed from the "Bcc" field; and,

(a.4) removing from any addresses specified in the "To" field, the "Cc" field and the "Bcc" field any addresses within a field used to specify addresses to be removed from all address fields.

8. (Previously Presented) A method for sending an electronic message comprising the following steps:

(a) in preparation for sending an e-mail message, performing the following substep:

(a.1) removing from any addresses specified in a "To" field, a "Cc" field and a "Bcc" field of the e-mail message any addresses within a field of the e-mail message used to specify addresses to be removed from all address fields.

(b) sending the e-mail message.

9. (Original) An electronic mail system for generating a message for being sent electronically, the message comprising the following fields:

a "To" field for listing primary addresses to receive the message; and,

a field used to specify addresses to be removed from the "To" field in preparation for sending the message.

10. (Original) An electronic mail system as in claim 9, the message additionally comprising the following fields:

a "Cc" field for listing addresses to receive a copy of the message; and,

a field used to specify addresses to be removed from the "Cc" field in preparation for sending the message.

11. (Original) An electronic mail system as in claim 9, the message additionally comprising the following fields:

a "Bcc" field for listing addresses to receive a blind copy of the message; and,

a field used to specify addresses to be removed from the "Bcc" field in preparation for sending the message.

12. (Original) An electronic mail system as in claim 9, the message additionally comprising the following field:

a field used to specify addresses to be removed from all address fields in preparation for sending the message.

13. (Original) An electronic mail system as in claim 9, the message additionally comprising the following fields:

a "Cc" field for listing addresses to receive a copy of the message;

a "Bcc" field for listing addresses to receive a blind copy of the message; and,

a field used to specify addresses to be removed from all address fields in preparation for sending the message.

14. (Previously Presented) An electronic mail system for generating a message for being sent electronically, the message comprising the following fields:

a plurality of address fields, the address fields comprising:

a "To" field for listing primary addresses to receive the message,

a "Cc" field for listing addresses to receive a copy of the message, and

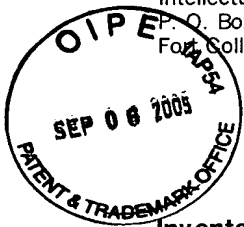a "Bcc" field for listing addresses to receive a blind copy of the message; and,

a field used to specify addresses to be removed from the address fields in preparation for sending the message.

EVIDENCE APPENDIX

No evidence under §§ 1.130, 1.131, or 1.132 is relied upon by Appellant in the appeal.

RELATED PROCEEDINGS APPENDIX
There are no related decisions rendered by a court or the Board.

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. ___10007711-1___

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s):   Phyllis A. Ellendman

Application No.: 09/916,971

Filing Date: July 26, 2001

Title: E-MAIL DISTRIBUTION WITH VERSATILE ADDRESS REMOVAL

Confirmation No.: 8593

Examiner: Michael Roswell

Group Art Unit: 2173

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on **August 19, 2005**.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) $500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

( ) (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

      ( )   one month $120.00
      ( )   two months $450.00
      ( )   three months $1020.00
      ( )   four months $1590.00

    ( ) The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **08-2025** the sum of ___**$500.00**___. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

(X) I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450. Date of Deposit:___**Sept. 1, 2005**___
                            OR

( ) I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number_____ on _____

Number of pages: _____

Typed Name: **Douglas L. Weller**

Signature: _____

Rev 12/04 (Aplbrief)

Respectfully submitted,

Phyllis A. Ellendman

By _____

Douglas L. Weller

Attorney/Agent for Applicant(s)
Reg. No.   **30,506**

Date: **August 31, 2005**

Telephone No.: **(408) 985-0642**